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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/748,228	12/27/2000	Fumihito Ohta	201372US2	3531
22850	7590	05/20/2004	EXAMINER	
OBLON, SPIVAK, MCCLELLAND, MAIER & NEUSTADT, P.C.				SHERALI, ISHRAT I
1940 DUKE STREET				
ALEXANDRIA, VA 22314				
ART UNIT		PAPER NUMBER		
		2621		

DATE MAILED: 05/20/2004

7

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No.	Applicant(s)
	09/748,228	OHTA, FUMIHITO
Examiner	Art Unit	
Sherali Ishrat	2621	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on 19 April 2004.
- 2a) This action is FINAL.                            2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 1-35 is/are pending in the application.
- 4a) Of the above claim(s) 13-35 is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) 1-12 is/are rejected.
- 7) Claim(s) \_\_\_\_\_ is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on 27 December 2000 is/are: a) accepted or b) objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) All    b) Some \* c) None of:  
1. Certified copies of the priority documents have been received.  
2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)	4) <input type="checkbox"/> Interview Summary (PTO-413)
2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)	Paper No(s)/Mail Date. _____
3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date <u>4</u> .	5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)
	6) <input type="checkbox"/> Other: _____

## DETAILED ACTION

### Election/Restrictions

1. Applicant's election with traverse of species 3, directed to figure 13, corresponding claims 7-12 in Paper N0. 7 is acknowledged. Examiner consider that claims 1-6 also reads on elected species 3 (figure 13). The traverse is on the ground (s) that the search and examination of the entire application could be made without serious burden. This is not persuasive because merely stating that the subject matter of all claims 1-35 is sufficiently related is not sufficient to overcome an election requirement. Additionally, the search required for calculating fail rates of respective compressed fail bit maps and distinguishing a fail shape based on fail rates, shown by figure 13 is different than the search required for calculating compression thresholds based on the number of fail bits, shown by figure 16. Moreover, if Applicant is traversing on the ground that the species are patentably distinct, Applicant should submit evidence or identify such evidence on record showing the species to be obvious variants. Paper No. 6 clearly stated that [MPEP 809.02(a)]

Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection /under 35 U.S.C. 103(a) of the other invention.

The requirement for election is still deemed proper and is therefore made FINAL.

## **Claim Rejections - 35 USC § 112**

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 1-12 are rejected under 35 USC § 112 as being indefinite.

Regarding claim 1, in lines 12-14, claim recites "plurality of compression areas having different size to convert into various forms in each of which a plurality of pixels of equal size to said their respective compression areas are arranged". The limitation "said their respective compression areas are arranged" lacks antecedent basis and it is in improper English form. Examiner recommends that it should recite plurality of compression areas having different sizes to convert into various forms in each of which a plurality of pixels of equal size are arranged in their respective compression areas.

Claims 2-3 and 10 are dependent on claim 1 therefore they are also rejected.

Regarding claim 4, in lines 11-13, claim recites "dividing said original fail bit map based on a predetermined compression area to convert into such a form that a plurality of pixels of equal size to said compression area". This limitation is in improper English form and it is not clear how to divide original fail bit map into single area. Examiner recommends that it should recite dividing said original fail bit map based on predetermined compression areas to convert into various forms that a plurality of pixels

Art Unit: 2621

of equal size are arranged in their respective compression areas. Claims 5-6 and 11 are dependent on claim 4 therefore they are also rejected.

Regarding claim 7, in lines 12-14, claim recites "plurality of compression areas having different size to convert into various forms in each of which a plurality of pixels of equal size to said their respective compression areas are arranged". The limitation "said their respective compression areas are arranged" lacks antecedent basis and it is in improper English form. Examiner recommends that it should recite plurality of compression areas having different sizes to convert into various forms in each of which a plurality of pixels of equal size are arranged in their respective compression areas.

Claims 8-9 and 12 are dependent on claim 7 therefore they are also rejected.

## **Allowable Subject Matter**

4. Claims 1-12 would be allowable if rewritten or amended to over come rejection under 35 USC § 112 second paragraph, set forth in this office action.

## **Communication**

5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to SherAli Ishrat whose telephone number is 703-308-9589. The examiner can normally be reached on 8:00 AM - 4:30PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Leo Boudreau can be reached on 703-305-4706. The fax phone numbers for the organization where this application or proceeding is assigned is 703-872-9306.

Art Unit: 2621

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-4750.



Ishrat Sherli

Patent Examiner

Group Art Unit 2621

May 12, 2004



LEO BOUDREAU  
SUPERVISORY PATENT EXAMINER  
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